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PAUL H. GALLAGHER
2439 JACKSON AVE
EVANSTON IL 60201

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OFFICE OF PETITIONS

In re Application of :
Aleks D. Nikolich :
Application No. 10/077,732 :
Filed: 19 February, 2002 :
Attorney Docket No. Case 1 :

DECISION DISMISSING REQUEST

~~In re Application of :
Aleks D. Nikolich :
Application No. 10/084,075 :
Filed: 27 February, 2002 :
Attorney Docket No. 1 :~~

This is a decision on the "Letter: Request to Establish Filing Date" filed on 18 June, 2002, which is treated as (a) a request to accord Application No. 10/077,732 a filing date of 23 February, 2001, and (b) a request that the \$370 basic filing fee submitted with the application assigned application No. 10/084,075 be refunded. This is also a decision in response to the communication filed by facsimile on 19 January, 2003, requesting merger of the application files.

Applicant states that the application was sent to the USPTO with a return receipt postcard, presumably by USPS first class mail, "within a day or two" after 7 October, 2001. The application papers included a check for \$370.00. After failing to receive confirmation from the USPTO that the application had been received, and being told by USPTO employees that the receipt of mail in the USPTO had been delayed because of the USPS mail decontamination procedures, applicant deposited a new application, accompanied by a return receipt postcard, with the USPS on 29 January, 2002. This application also included a check for \$370.00. The return receipt postcard from the "first" application was ultimately returned bearing an "Office-date" of 02/27/02, while the postcard from the "second" application was returned with an "Office-date" of 02/19/02. Additionally, the check sent with the first application was deposited on 6 March, 2002, while the check sent with the second application was

deposited on 26 February, 2002.

Applicants request that the application be given the filing date of the prior provisional application, 23 February, 2001, and that the second filing fee be refunded.

Request for Earlier Filing Date

With regard to petitioner's request that "the application" be given the filing date of the prior provisional application, 23 February, 2001. It is noted, at the outset, that application papers are entitled to a filing date of the date the papers are received in the Office.¹

Further, the evidence and arguments submitted by petitioner have been considered; however, they are not convincing that the first application was, in fact, received in the Office on 23 February, 2001, 7 October, 2001 (the alleged date of deposit), or anytime prior to 19 February, 2002.

35 U.S.C. 21(a) provides that:

The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director.

The Director may, but is not required to, accept the mailing date as the filing date. The Director has determined that only the "Express Mail" procedure can be used for this purpose because the use of "Express Mail" provides very specific identifying

¹37 CFR 1.6. Petitioner asserts that 37 CFR 1.53(c)(3) entitles applicants to the filing date of an earlier-filed provisional application. For a nonprovisional application to receive the filing date of a prior-filed provisional application under 37 CFR 1.53(c)(3), however, petitioner would have had to file a timely petition to convert the provisional application to a nonprovisional application rather than an application under 37 CFR 1.53(b). A review of the record reveals that no petition to convert the prior provisional application to a nonprovisional application was ever filed. Any such petition would have had to have been filed prior to 23 February, 2002, twelve months after the date the provisional application was filed, in order to be timely. 37 CFR 1.53(c)(3)(ii). It is noted, however, that a nonprovisional application may claim the benefit of the filing date of a prior-filed provisional application if the requirements of 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5) are satisfied. See MPEP 201.11. Note, in particular, the time period requirement for making the benefit claim.

information in advance which establishes both the date of mailing and the particular papers being filed.

Because the filing date of an application is much more critical than the filing date of papers accepted under 37 CFR 1.8, the USPTO promulgated a separate rule, 37 CFR 1.10, which sets forth a specific procedure which must be followed in order to establish the filing date as the date of deposit with the United States Postal Service (USPS) instead of the date of receipt in the Office.

The procedure in 37 CFR 1.10 requires the use of the "Express Mail Post Office to Addressee" service of the USPS. Correspondence sent by the "Express Mail Post Office to Addressee" service is considered filed in the Office on the "date-in" entered by the USPS. If the USPS deposit date cannot be determined, the correspondence will be accorded the date of receipt in the Office as the filing date. If the procedure is not followed, applicants bear the risk of any delay in the delivery of the application papers to the Office.

In the instant petition, there is no allegation that the application papers deposited on 7 October, 2001, with the USPS as first class mail to the Office, were deposited in compliance with the "Express Mail" procedures set forth in 37 CFR 1.10. Petitioner had the option of depositing the application papers in "Express Mail" service on 7 October, 2001, in order to obtain the benefits of 37 CFR 1.10. Had petitioner followed the procedure set forth in 37 CFR 1.10, the application could have been accorded a filing date as of the date of deposit in "Express Mail." Thus, petitioner could have avoided the instant predicament merely by following the procedures established by the Director. Instead, petitioner chose to deposit the application papers in first class mail and, as such, assumed the risk of any delay in the delivery to the Office. Petitioner's failure to take advantage of the established procedures is not a justification for accepting a date based upon the 7 October, 2001 mailing of the instant application papers by first class mail as the filing date of the above-identified application. Therefore, the application is only entitled to the 19 February, 2002 receipt date as the filing date of the application.

The best evidence of when particular application papers were actually received by the USPTO is a postcard receipt containing a specific itemization of all the items being submitted. See MPEP 503. In the absence of a postcard receipt indicating the

receipt in the USPTO of the application papers on an earlier date, the USPTO must rely on the Official record, which indicates that the instant application papers were not received in the USPTO until 19 February, 2002.

In view of the above, the petition is dismissed. No petition fee is required.

Decision on Request for Refund

It is noted that there was no indication in the application papers filed on 19 February, 2002, and assigned application No. 10/077,732, that the application was a duplicate of a previously submitted application.

The fact that applicant has filed duplicate or substantially duplicate applications does not entitle applicant to a refund of the filing fee. The application papers filed on 27 February, 2002, as application No. 10/084,075, are entitled to a filing date of 27 February, 2002, and the filing fee paid in application No. 10/084,075 is the fee required by law. Similarly, the application papers filed on 19 February, 2002, as application No. 10/077,732, are entitled to a filing date of 19 February, 2002, and the filing fee paid in application No. 10/077,732 is the fee required by law.

37 CFR 1.26(a) reads:

(a) The Commissioner may refund any fee paid by mistake or in excess of that required. **A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.** The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Commissioner may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account

to which the fee was charged. (Emphasis added).

Section 607.02 of the Manual of Patent Examining Procedure, Eighth Edition (August 2001) reads, in part, as follows:

Under 35 U.S.C. 42(d) and 37 CFR 1.26, the Office may refund: (1) a fee paid by mistake (e.g., fee paid when no fee is required); or (2) any fee paid in excess of the amount of fee that is required. See *Ex parte Grady*, 59 USPQ 276, 277 (Comm'r Pat. 1943) (the statutory authorization for the refund of fees under the "by mistake" clause is applicable only to a mistake relating to the fee payment). **When an applicant or patentee takes an action "by mistake" (e.g., files an application or maintains a patent in force "by mistake"), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d).** 37 CFR 1.26(a) also provides that a change of purpose after the payment of a fee, as when a party desires to withdraw the filing of a patent application for which the fee was paid, will not entitle the party to a refund of such fee. (Emphasis added and error corrected).

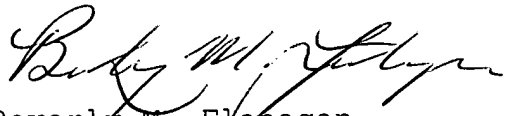
Accordingly, the request is dismissed.

Applicant may wish to consider filing a letter of express abandonment under 37 CFR 1.138 in Application No. 10/084,075 since it has a later filing date than Application No. 10/077,732.

Application No. 10/077,732 is being forwarded to Technology Center Art Unit 3651 for examination in due course.

Application No. 10/084,075 is also being forwarded to Technology Center Art Unit 3651 for examination in due course.

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Douglas I. Wood at (703)308-6918.


Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions